

REMARKS

The following remarks are provided in response to the Office Action dated January 28, 2005 in which the Examiner:

- rejected claims 1-2, 4-7, 9-10, 13, 25, 27-29, and 31-38 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Misra et al. (hereinafter Misra) in view of Gradient, "Gradient Introduces End User Software License Creation and Delivery Tool for its iFOR/LS Licensing Technology," dated March 21, 1994 (hereinafter Gradient) and U.S. Patent No. 5,708,709 to Rose.
- rejected claims 39-42 under 35 U.S.C. §103(a) for being unpatentable over Misra in view of Rose

The applicants respectfully request reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections.

35 U.S.C. §103(a)

The Examiner rejected claims 1-2, 4-7, 9-10, 13, 25, 27-29, and 31-38 under §103(a) as being unpatentable over Misra in view of Gradient and Rose and claims 39-41 under §103(a) as being unpatentable over Misra in view of Rose. For at least the following reasons the applicants traverse the Examiner's rejections.

A *prima facie* case of obviousness under 35 U.S.C. §103 requires, among other criteria, that ". . . the prior art reference (or references when combined) must teach or suggest **all** the claim limitations." (emphasis added) (See M.P.E.P. 706.02(j) and 2143.03). To overcome a §103(a) rejection, the applicants must only demonstrate that the

cited prior art document or documents fail individually and in combination to teach or suggest one element or limitation present in the claim.

The salient portion of currently amended independent claim 1 recites:

receiving, by the local computer, a ping from a remote computer;
obtaining, by the local computer **in response to generating the install license**
and receiving the ping, from the remote computer a trial license for the
installed software, wherein the trial license is generated by the remote
computer;
(emphasis added)

Currently amended independent claims 13, 35, and 39 recite a similar limitation. The applicants herein cancel claims 36 and 41. The Examiner rejected independent claims 35 and 39, an element of which has been included in currently amended independent claims 1 and 13 alleging that Misra Figure 5 and column 14 lines 1-29 disclose receiving a ping from an external software license servicing agent. The applicants disagree. Column 4 lines 5-8 disclose that “[t]he client 30 may or may not have a valid license so the intermediate server makes an initial evaluation when the client attempts to connect.” Additionally, with reference to Figure 5, “[a]t step 172, the client 30 submits a connection request to the intermediate server.” The applicants assert that the cited portions of Misra disclose **that the client initiates the license procurement and / or validation and not the reverse.** The applicants therefore affirm that the cited portions of Misra cannot teach receiving, by the local computer, a ping from a remote computer as recited by currently amended independent claims 1, 13, 35, and 39. Accordingly, the applicants submit that currently amended independent claims 1, 13, 35, and 39 are patentable as each recites at least an element not disclosed by Misra in view of Gradient and Rose.

As dependent claims 2, 4-7, 9-10, 25, 27-29, 31-34, 37-38 and 40 depend from

nonobvious independent claims, the dependent claims are also nonobvious. (See M.P.E.P. §2143.03 (citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988))).

CONCLUSION


For at least the foregoing reasons, the applicants submits that they have overcome the Examiner's rejections and that they have the right to claim the invention as set forth in the listed claims. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,

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Dated



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